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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/699,313  | 10/30/2003  | Lon S. Weiner        | M913.12-9           | 3934             |
| 40306   | 7590        | 06/30/2006           | EXAMINER            |                  |
| SHEWCHUK IP SERVICES<br>533 77TH STREET WEST<br>EAGAN, MN 55121 |             |                      | DAVIS, DANIEL J     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3733                |                  |

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8P

|                              |                 |               |
|------------------------------|-----------------|---------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)  |
|                              | 10/699,313      | WEINER ET AL. |
|                              | Examiner        | Art Unit      |
|                              | D. Jacob Davis  | 3733          |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 17 February 2004 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  - 1. Certified copies of the priority documents have been received.
  - 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/1/03 10/30/03.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION*****Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected on the ground of nonstatutory double patenting over claims 1-20 of U. S. Patent No. 6,746,448 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. The claims of the '448 patent are narrower in scope but clearly anticipate the claims in the present application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1, 13 and 16 are rejected on the ground of nonstatutory double patenting over claims 1, 17, 24-26 of U. S. Patent No. 6,652,524 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the '524 patent describes outrigger extending over the bone, which is the "wrap around angle." The '524 patent describes the outrigger angled relative to the longitudinal axis, which is comparable to the "plane" described in the present invention.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 6,056,748 to Weiner. The '748 patent discloses an external fixator (Fig. 1) comprising a main body 12, an outrigger/track 14, and a first bone fastener support, which is slidably attached to the outrigger. As illustrated in Fig. 1, near the ends of the outrigger 14, there is a slope that changes from parallel to perpendicular to the reference plane. The fastener may move to this slope and become angled relative to the plane.

Although '748 does not illustrate or make reference to openings on the track, inherently the track must have openings since the track ends mate with elements 56 (Fig. 2C). The first bone fastener support is the more proximal of the two supports, as illustrated in Fig. 1. The first support may move from its present location to the main body 12. The second support may move from its present location, wrap around to the other side of the outrigger 14, and finally to the other end of the outrigger near the main body. Some portions of the two paths are at a wrap around angle with respect to one another. The angle of the first support path relative to the plane changes between 180 degrees (parallel to the plane) and 90 degrees (perpendicular to the plane) as determined by the referred to slope. The outrigger may be secured both to the right or to the left of the main body since the main body may be rotated about its longitudinal axis 180 degrees. The rotation also creates a first and second position.

Regarding claim 11, the outrigger would extend distally (or away) from the main body no matter what direction the outrigger was extending from the main body. The track can be divided into two portions, both of which meet at the curved tip of the outrigger. Illustrated in Fig. 1, lead line 14 points to the curved tip.

Regarding claim 13, Fig. 1 illustrates two fastener supports that may move in a linear direction along the outrigger. The first (the closer one to the main body) may move within a linear direction along the short linear portion of the track, on which the support is located. Furthermore, the second support may move linearly from its present location to the lead line 14. The two paths of the supports are at a "wrap around angle" with respect to one another. The track is in the form of an I-beam, which continues even between the two track path portions. The portion between the two linear paths is a curved portion. The edges of the curved I-beam track form a strengthening web between the linear paths.

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,527,309 to Shelton. The '309 patent discloses an external fixator capable of being used with a fractured bone. The fixator comprises a main body 14, an outrigger 10, and a first bone fastener support 20. The outrigger is pivotally attached to the main body 14 since the connection between the body and outrigger permits a relative rotation even at both negative and positive angles. The fact that the pins are attached to the pelvis does not preclude the pivotal relationship between the outrigger and the main body. Once the pins attached to the pelvis are released, the outrigger may have a

greater range of positive than negative angles. In its present negative angle, shown in Fig. 1, the device may rotate somewhat further in the negative direction until it contacts the pelvis. It also could rotate the opposite direction until it is entirely behind the pelvis and contacts the pelvis from the positive or the "back side". The back side of the reference plane is a positive angle and has a greater range than the negative side of the plane.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 2,333,033 to Mraz. Mraz discloses an external fixator (Fig. 3) comprising a main body 11, an outrigger 23 and 25, and bone fasteners 27. The fasteners may be received through either the proximal end or the distal end of the outrigger 23 and 25.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 6,056,748 to Weiner in view of U.S. Pat. No. 5,897,555 to Clyburn et al. Weiner discloses the limitations of claim 1 but fails to disclose that the device may be made of plastic. Nevertheless '555 teaches the use of an external fixation system, wherein the

Art Unit: 3733

major "body" parts are made of plastic because plastic is rigid, lightweight, and inexpensive to manufacture, col. 7, lines 45-51. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made the major "body" parts, such as the main body 12 and the outrigger 14 of the '748 device out of plastic as taught by '555 in order to make the device rigid, lightweight, and inexpensive to manufacture.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,527,309 to Shelton. Shelton discloses a first fastener support 20, but fails to disclose a second bone fastener support. Nevertheless, adding another fastener support would more effectively secure the outrigger 12 to the pelvis. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add another fastener support to more effectively secure the outrigger 12 to the pelvis. The paths of the two supports, as they traverse from one end of the device to the other, would result in changes in elevation with respect to the plane.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Jacob Davis whose telephone number is (571) 272-4693. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo C. Robert can be reached on (571) 272-4719. The fax phone

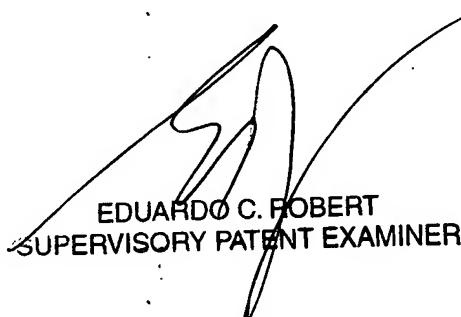
Art Unit: 3733

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DJD



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SUPERVISORY PATENT EXAMINER